



Docket No. DELME-P2739

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dan W.C. Delmer

Serial No.: 09/904,975

Art Unit: 3679

Filed: July 12, 2001

Examiner: Aaron M. Dunwoody

For: COUPLING FOR PIPE AND RELATED METHODS

Mail Stop Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RECONSIDERATION REQUEST FOR PETITION FOR REVIVAL OF AN
APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR
1.137(b)**

Sir:

Please find attached herewith as set forth in 37 C.F.R. §1.137(b)(1)-(3):

(1) A reply;

(2) Statement of unintentional delay.

All applicable petition fees were paid by Applicant in a previously submitted petition for revival mailed January 18, 2006. Accordingly, Applicant believes no fees are due in connection with the present request for reconsideration of petition for revival.

If Applicant is incorrect in this regard, the Patent Office is authorized to charge any fees due, or credit any overpayment, to Deposit Account No. 08-2624.

Certificate of Mailing

I hereby certify that this correspondence and all attachments are being deposited with the United States Postal Service First Class Mail Post Office to Addressee, service on the date indicated below and addressed to Mail Stop: Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Mark A. Pellegrini, Reg. No. 50,233

4/21/06

DATE

STATEMENT OF UNINTENTIONAL DELAY

Applicant hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to paragraph 37 C.F.R. §1.137(b)(3) was unintentional.

BASIS FOR APPLICANT'S RECONSIDERATION REQUEST

In the above-indicated Petition to Revive dated January 18, 2006, Applicant filed a reply amending Claims 2, 8, and 10 by rewriting each in independent form including all of the limitations of the base claim and any intervening claims in accordance with the Examiner's Final Office Action mailed November 19, 2003. All other claims not depending from Claims 2, 8, and 10 were cancelled.

As indicated in the USPTO correspondence mailed March 14, 2006 (decision on the petition), "Per the Examiner, amended claims 8 and 10 have included an extended preamble drawn to an apparatus, but the apparatus is not part of the claimed invention of a stretching tool (claim 8) or a temporary stretch-holding device (claim 10), which are claimed in the body of their respective claims." (Page 2, Footnote 1) Accordingly, the reply/amendment was deemed an improper response for failing to place the application in *prima facie* condition for allowance resulting in dismissal of the petition.

Subsequent to receiving the decision on the petition, Applicant's representative contacted USPTO Examiner Aaron Dunwoody and the examiner's supervisor Mr. Stodola separately to discuss substantive matters relating to the alleged improper claim amendments to Claims 8 and 10.

In this regard, Claim 8, prior to being amended read as follows:

"A stretching tool for use in connection with the apparatus of Claim 1, including a channel into which an edge of said first piece of pipe can be inserted in its originally fabricated shape, said tool including means to temporarily deform said edge of said first piece of pipe."

As indicated above, Claim 8 discloses an intended use for the stretching tool with an apparatus written in shorthand notation, i.e., the apparatus disclosed in longhand in Claim 1. Similarly, Claim 10, as drafted prior to the amendment, included in shorthand notation an apparatus, that of Claim 1, intended for use with a temporary stretch-holding device. Accordingly, Applicant did not intent to positively claim the apparatus in Claims 8 and 10, but merely to recite the apparatus as a device for use with the positively claimed stretching tool.

Upon review of the amendments contained in the January 18, 2003 reply, Supervisor Stodola, indicated that Applicant's amendment of Claims 8 and 10 were properly rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Likewise, Examiner Dunwoody indicated that Claims 8 and 10 were properly rewritten as suggested in the November 23, 2003 Final Office Action. However, Examiner Dunwoody further indicated that it was his belief that Applicant actually intended to include as a claimed element the apparatus of Claim 1 in each of Claims 8 and 10. Accordingly, Examiner Dunwoody indicated that the reply should have been deemed proper and that any discrepancy or misunderstanding between the Examiner's and the Applicant's interpretation of Claims 8 and 10 could have been properly handled by reopening prosecution with a Non-Final Office Action after granting of the petition to revive.

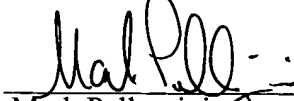
Based on the foregoing remarks, Applicant believes the response provided herewith is a proper reply amending Claims 2, 8, and 10 by rewriting each in independent form including all of the limitations of the base claim and any intervening claims in accordance with the Examiner's Final Office Action mailed November 19, 2003. An Examiner's acceptance of the response, and granting of petition to revive by the Office of Petitions is respectfully requested.

If the Office of Petitions or the Examiner has any questions regarding the foregoing, or if either would like to discuss any remaining or new issues regarding this communication, each is invited to contact the undersigned representative of Applicant at (949) 718-6750.

Date:

4/21/06

Respectfully submitted,



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Enclosures

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REPLY AS REQUIRED UNDER 37 CFR 1.137(b)

Claims

Claims 1-3, 5-15, and 19-26 were previously presented. In the present amendment Claim 1 and Claims 19-26 have been canceled without prejudice. Thus, after entry of the present amendment, Claims 2-3 and 5-15 will be pending.

Specification

Applicant has changed the title of the invention to PIPE COUPLING as suggested by the Examiner.

Claim Objections

Claims 1 and 19-22 were objected to for the following alleged informality: Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. The Examiner requires appropriate corrective action.

Applicant has cancelled Claims 1 and 19-22 as indicated herein, and respectfully submits that the objection has been overcome. However, in this regard, 37 CFR 1.75(i) states, "Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation." (emphasis added) Further in this regard, the MPEP at 608.01(m) indicates that there is no set statutory form for claims. Accordingly, although it may be appropriate for Applicant to have separated each element or step by a line indentation, the Applicant is not required to do so to meet the statutory requirements as set forth in the Patent Rules.

Therefore, Applicant respectfully submits that independent Claims 1, 19, and 20 were in proper form as originally filed. In rewriting Claim 2 into independent form including all of the

limitations of the base claim and any intervening claim Applicant included line indentations to separate each element or step as required by the Examiner. Applicant believes that changes made to the claims to overcome the Examiner's objection affect only the form of the claims and not the scope or substance thereof. In other words, Applicant respectfully submits and intends that the foregoing formal change (regarding line indentation) does not affect, limit, or narrow in any way the subject matter covered by the claims.

Claim Rejection

Claim 19 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has canceled Claim 19.

Allowable Subject Matter

The Examiner has indicated that Claims 2 and 8-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has rewritten Claims 2, 8 and 10 in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claim 2 (Claims 3, and 5-7 dependent thereon), Claim 8 (Claim 9 dependent thereon), and Claim 10 (Claims 11-15 dependent thereon) are therefore in condition for allowance, notice whereof is respectfully requested of the Examiner.

In view of the amendments and remarks set forth above, it is thought that the application including Claims 2-3, 5-15 is now in condition for allowance, notice whereof is respectfully requested of the Examiner.